

CHARLES G. NESSLER
PATENT AND TRADEMARK ATTORNEY
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May 9, 2000

Asst. Commissioner of Patents
Washington, DC 20231

Attention: PCT Legal Office

Sent to PTO
3:47 PM
May 10, 2000
Wednesday

RENEWED PETITION UNDER 37 CFR 1.181

Re: Application No. 08/962,077 Golicz et al. Sheet Feeding Apparatus

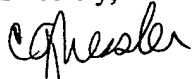
Sirs:

Enclosed herewith is a renewed petition which is a request for reconsideration of the Decision issued March 31, 2000.

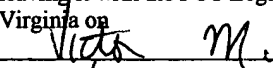
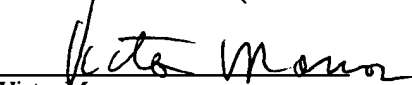
Applicants do not believe any fee is payable, but if that is the case, please charge same to Deposit Account No. 14-0711.

Applicants strongly believe their request for reconsideration has merit and that the decision ought be changed. However, if that turns out to not be the case, applicants intend to file a request to revive under 37 CFR 1.137. The PTO Legal Office is earnestly requested to issue any further decision in a procedural way which allows applicants to file the further petition under Section 1.137.

Sincerely,


C. G. Nessler
Attorney for Roman Golicz et al.

I hereby certify that this correspondence was hand delivered to the Assistant Commissioner of Patents, by leaving it with the PCT Legal Office section in Arlington, Virginia on

 M. (date) May 10, 2000

Victor Manos

RECEIVED
22 MAY 2000
Legal Office
Information Division

CHARLES G. NESSLER
PATENT AND TRADEMARK ATTORNEY
BOX H, CHESTER, CT 06412
PHONE (860) 526-9149
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June 8, 2000

Asst. Commissioner of Patents
Washington DC 20231

Attention: PCT Legal Office - Daniel Stemmer Esq.

Re: Application No. 08/962,077 Golicz et al.
Renewed Petition under 37 CFR 1.181

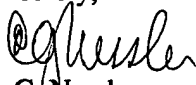
The undersigned Applicants' attorney has noted with some embarrassment that in the Renewed Petition dated May 9, 2000, that there is a persistent and obvious "typographic" error in the following respect.

On the first page of the Petition, at Summary paragraph "C", and on pages 3 and 4, in Part C itself, the text refers to (non-existent) "37 CFR 371" and "37 CFR 111" at multiple places. It will be appreciated that the intent of the writer was to state "35 USC 371" and "35 USC 111". Those are the relevant and familiar code sections which are referred to at the beginning of Part C and in the earlier Decision of the PCT Legal Office.

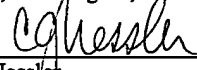
The PCT Legal Examiner is respectfully requested to make the requisite corrections and/or read the Petition in accord with this letter.

Applicants' attorney regrets the error.

Sincerely,


C. G. Nessler

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on June 9, 2000.


C. G. Nessler

RECEIVED
17 JUN 2000
Internal Mail

PCT LEGAL OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application of Roman Golicz et al.

Serial No. 08/962,077

Date: May 9, 2000

Filed: October 31, 1997

Applicant: Roman Golicz et al.

Title: Sheet Feeding Apparatus

Atty. No. 9534

To: Asst. Commissioner for Patents

RECEIVED

10 MAY 2000

Legal Staff
International Division

RENEWED PETITION UNDER 37 CFR 1.181

REQUEST FOR RECONSIDERATION OF THE MARCH 31, 2000 DECISION
OF THE PCT LEGAL OFFICE

Applicant respectfully requests reconsideration of the Conclusions in the 31 March 2000 "Decision on Petition under 37 CFR 1.181..." (hereafter called "Decision"). Applicant submits that there are rules and facts which, when fully considered, change the conclusions.

A. Primarily, applicant submits that, since the Decision held the application was a 35 USC 111(a) application, based on it being stated to be a continuation, the application therefore has a filing date of 31 October 1997, pursuant to 37 CFR 53 and MPEP 1896.

B. Secondly, and related to Part A, applicant submits that the Decision ought not say the declaration does not properly identify the specification to which it is directed.

C. *In the alternative* (and to preserve their rights), applicants ask reconsideration of the conclusion that the application is not one made under 37 CFR 371.

If reconsideration of Part A leads to a filing date of 31 October 1997, applicants' request for reconsideration under Part C should be considered to be moot and withdrawn.

PART A

Inasmuch as the Decision concluded the application was a 35 USC 111(a) national application, based on it having been identified as a continuation, the application therefore has a filing date of 31 October 1997, pursuant to 37 CFR 53 and MPEP 1896.

1. The USPTO/USRO received the specification on 1 April 1997 -- the date on which application PCT/US97/05320 ("the PCT application") was filed. Form PCT/DO/EO/901(a), having a

presumed 19 May 1997 mailing date, recorded the sending of the application to the US as designated office. See copy attached.

2. Form PCT/1B/308 shows the USPTO national office received the very same specification on about October 9, 1997 from the International Bureau. See copy attached.

3. On 31 October 1997, the USPTO received the applicants' declaration, the fee and a statement on a separate paper that the application was a continuation of the PCT application. Applicants in their declaration stated that the specification was that document which was the PCT application, identifying it by number and filing date.

4. Pursuant to MPEP 1896, last paragraph, entitled "Reference to Application in Declaration", applicant can file a PCT-related national application under 35 USC 111(a), wherein:

"The specification may be identified in a U.S. national application filed under 35 USC 111(a) by reference to an attached specification or by reference to the application number and filing date of a specification previously filed in the Office."

5. Filing requirements for continuations are set forth at 37 CFR 1.53(d)(2). The section provides that the filing date of a continued prosecution application is the date on which the request is filed. This was done on 31 October 1997 and the application was complete at that time.

6. The PCT application priority date is 1 April 1996. Thus, on 31 October 1997 the PCT application was pending. It therefore was permissible to file a continuation thereof.

7. Thus, the Decision's analysis and conclusion should be reconsidered and revised, to take into account the above-cited regulations and procedure relating to continuations. The procedure set forth in MPEP 1896 particularly contemplates the present situation. The filing date should be deemed to be 31 October 1997.

Part B.

The declaration filed 31 October is not defective, irrespective of what the filing date is.

1. The first full paragraph of the Decision, on Page 4, says that the 31 October 1997 declaration is defective because it does not properly identify the specification.

2. However, the specification is a document which is of record, and the declaration identifies that document with specificity. The document happened to be an international PCT application. That fact does not undercut the fact that it is a specification describing the invention.

3. The Decision cites MPEP 1896. However, MPEP last paragraph is inapposite. See Section A(4) above.

5. Withdrawal of the requirement, or a more specific citation of authority, is requested.

Part C.

The application was filed pursuant to 35 USC 371 within the meaning of 1077 OG 13 and MPEP 1893.03(a)

1. On the issue of whether the application was a filing under 35 USC 371 or 35 USC 111(a), the Decision says there was “no indication the application was being submitted under 37 CFR 371” (page 3). It cites the words in the transmittal letter, “This application is a continuation of the aforementioned PCT application”.

2. However, MPEP 1893.03(a) states that

“...if the applicant ... clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Application Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application, then the application will be accepted as filed under 35 USC 371.”

Furthermore, 1077 OG 13 states, as an alternative to the PTO Form 1390, that the following indications of a 37 CFR 371 application may be used:

1) (applicant clearly states in cover letter that a 37 CFR 371 filing is being made)

OR

2) applicant clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Application Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

The words of Item (2) are the same as in MPEP 1893.03(a).

3. Applicant met the requirement for (2). See a copy of the declaration, attached. Thus, the Decision ought to reflect that there is a *prima facie* indication of intent to file under 37 CFR 371.

4. The MPEP and OG do go on to state that if there are *conflicting instructions*, the application will be treated as filed under 35 USC 111(a). It is true that one can read into the transmittal letter that continuing prosecution is desired. But, just below, applicants submit how other aspects of the filing ought to also be weighed to determine what are the “instructions”.

5. The Commissioner’s (and PCT Legal Office) decision making is presumed to be made generally in accord with civil procedure. In this context, there ought to be a weighing of the evidence/words, in determining if there is in fact “conflicting instruction”. For example, if there is a mere inconsistency in wording, a stray or wrong mention, or confusion, etc., they do not reasonably constitute conflicting instruction if the preponderance of what is intended is otherwise conveyed.

Secondly, as stated at paragraph C(3) just above, there is a prima facie basis for a filing under 37 CFR 371. Thus, normal jurisprudential principles dictate that anything in opposition thereto has to have sufficient import, to rise to the level where a conflict is created. Obviously, the wording of the transmittal letter sentence does not support a 37 CFR 371 filing. But, the question is whether the words are an instruction sufficient to constitute conflict. It is not as if applicants said at one place "file under 37 CFR 371" and at another "file under 37 CFR 111".

6. Applicants submit that when the other evidence supporting the 37 CFR 371 filing is considered, there is no doubt they intended a 371 filing. Consider:

a. Applicants' attorney obtains his empowerment from the grant of power in the declaration. The verified declaration language thus has priority over the lawyer transmittal letter language. Therefore, the application must be a 35 USC 371 application based on the declaration.

b. In the attorney's letter, there is no reference to 37 CFR 111 which would surely create a conflict. There is only an implied conflict from the word "continuation".

c. Applicants' attorney's use of the word "continuation" may be considered to be used in its generic or general sense. Note, how MPEP uses *wrong* "continuing" language, in context of a 35 USC 371 application. See MPEP 1895.01, Section A, about Continuing Data, extract attached.

d. Applicants submitted with the filing a copy of the international search report. This is consistent with a 37 CFR 371 application versus a 37 CFR 111(a) application.

e. Applicants enclosed Form PCT/1B/308 with its two paragraphs relating to National Phase, consistent with a 35 USC 371 filing and not a 37 CFR 111(a) filing.

7. Thus, applicants submit that the one sentence/word in the transmittal letter is clearly subordinate and outweighed by the prima facie instruction and all the other implied instructions and supporting evidence for a 37 CFR 371 filing. Thus there is no conflicting instruction.

8. Certain equitable aspects ought to be weighed if there is a close decision, which appears here to applicants to be the case. The file history shows PTO did not notify applicants of incomplete application until 9 months after the receipt of the application. Then, after discussions, PTO sent a filing receipt. This led applicants to believe that their filing date was accepted. They acted in reliance upon such by (a) withdrawing the petition which was filed, and (b) other inaction.¹ Next PTO refused to accept withdrawal of the petition, but instead continued to process it.² However, applicants were unaware of this. Then, the PTO petitions examiner did not act on the petition for more than 17 months, during which time applicants thought they were in a queue in the patentability examining division. PTO did not respond to a number of status inquiries and phone

¹ Applicants had a co-pending application, Serial No. 08/831,356, now patent 5,971,389, which had disclosure of the subject invention here. That application provided the basis for a continuing or CIP application claiming the invention subject of the instant application. Relying on the filing receipt, and apparent resumed normal processing, applicants allowed the application to issue without any such continuation filing.

² Notwithstanding, applicants do not argue that the PTO cannot sua sponte review its past actions and rectify errors.

calls. Applicants' personal representative had to contact the petitions examiner; whereupon she sent the petition/matter to the PTO legal office.

9. Paragraphs (1) through (4) of Part A hereof are repeated as if they were written here. For reasons set forth therein, the filing date of the 37 CFR 371 application is 31 October 1997.

10. Therefore, the Decision ought to be modified by concluding that a filing was made under 37 CFR 371 on 31 October 1997.

Respectfully submitted,
ROMAN GOLICZ et al.

By Charles G. Nessler
Their Attorney

Charles G. Nessler
Box H
Chester, CT 06412
(860) 526 9149

I hereby certify that this correspondence was hand
delivered to the Assistant Commissioner of Patents, by
leaving it with the PCT Legal Office section in Arlington,
Virginia on _____ (date)

Victor Manos

INTERNATIONAL PATENT COOPERATION TREATY

Form IB/308

PCT

NOTICE INFORMING THE APPLICANT OF THE
COMMUNICATION OF THE INTERNATIONAL
APPLICATION TO THE DESIGNATED OFFICES

(PCT Rule 47.1(c), first sentence)

From the INTERNATIONAL BUREAU

To:

NESSLER, Charles, G.
P.O. Box H
Chester, CT 06412
ETATS-UNIS D'AMERIQUE

Date of mailing (day/month/year) 09 October 1997 (09.10.97)		IMPORTANT NOTICE	
Applicant's or agent's file reference 9534			
International application No. PCT/US97/05320	International filing date (day/month/year) 01 April 1997 (01.04.97)	Priority date (day/month/year) 01 April 1996 (01.04.96)	
Applicant GOLICZ, Roman, M. et al			

1. Notice is hereby given that the International Bureau has communicated, as provided in Article 20, the international application to the following designated Offices on the date indicated above as the date of mailing of this Notice:

US

In accordance with Rule 47.1(c), third sentence, those Offices will accept the present Notice as conclusive evidence that the communication of the international application has duly taken place on the date of mailing indicated above and no copy of the international application is required to be furnished by the applicant to the designated Office(s).

2. The following designated Offices have waived the requirement for such a communication at this time:

DE,GB

The communication will be made to those Offices only upon their request. Furthermore, those Offices do not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis)).

3. Enclosed with this Notice is a copy of the international application as published by the International Bureau on 09 October 1997 (09.10.97) under No. WO 97/36812

REMINDER REGARDING CHAPTER II (Article 31(2)(a) and Rule 54.2)

If the applicant wishes to postpone entry into the national phase until 30 months (or later in some Offices) from the priority date, a demand for international preliminary examination must be filed with the competent International Preliminary Examining Authority before the expiration of 19 months from the priority date.

It is the applicant's sole responsibility to monitor the 19-month time limit.

Note that only an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II has the right to file a demand for international preliminary examination.

REMINDER REGARDING ENTRY INTO THE NATIONAL PHASE (Article 22 or 39(1))

If the applicant wishes to proceed with the international application in the national phase, he must, within 20 months or 30 months, or later in some Offices, perform the acts referred to therein before each designated or elected Office.

For further important information on the time limits and acts to be performed for entering the national phase, see the Annex to Form PCT/IB/301 (Notification of Receipt of Record Copy) and Volume II of the PCT Applicant's Guide.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. (41-22) 740.14.35	Authorized officer J. Zahra Telephone No. (41-22) 338.83.38
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TO

CHARLES G. NESSLER
P.O. BOX H
CHESTER CT 06412UNITED STATES DESIGNATED/ELECTED
OFFICE (DO/EO/US)NOTIFICATION OF STATUS OF
REQUIREMENTS UNDER 35 U.S.C. 371

DATE OF MAILING

FILE REFERENCE 9534

ENCLOSED
WITH PAPERS
HAVING
19 MAY 1997
MAILING
DATE

IDENTIFICATION OF INTERNATIONAL APPLICATION

International Application Number	International Filing Date	Priority Date Claimed
PCT/US97/05320	01 APR 97	02 APR 96
Applicant for DO/EO/US		
GOLICZ, ROMAN M.		

NOTIFICATION

The applicant is hereby advised that the U.S. Patent and Trademark Office in its capacity as ☒ Designated Office ☐ Elected Office has received the following items as of the date of mailing indicated above.

1. ☐ U.S. National fee [35 U.S.C.371 (c) (1)]
2. ☐ Oath of declaration [35 U.S.C.371 (c) (4)]
3. ☒ Copy of International application as filed [35 U.S.C.371 (c) (2)]
4. ☐ Translation of Application [35 U.S.C.371 (c) (2)]
5. ☐ Amendments under PCT Article 19 [35 U.S.C.371 (c) (3)]
6. ☐ Translation of PCT Article 19 Amendments [35 U.S.C.371 (c) (3)]
7. ☐ Search Report or Declaration under PCT Article 17(2) [35 U.S.C.371 (a)]
8. ☐ International Preliminary Examination Report and its Annexes, if any, under PCT Article 36(3) (a) [35 U.S.C.371 (a)]
9. ☐ Translation of Annexes to the International Preliminary Examination Report under PCT Article 36(3) (b) [35 U.S.C.371 (c) (5)]
10. ☐ Other items received:
☐ Assignment Document ☐ Prior Art Statement ☐ Preliminary Amendment
- A. ☐ Requirements for U.S. National processing have been met. Processing will commence
☐ at the expiration of the applicable time limit under either
☐ PCT Article 22 [35 U.S.C.371 (b)] or
☐ PCT Article 39 [35 U.S.C.371 (b)]
☐ on the date indicated below under the provisions of 35 U.S.C.371 (f)

U.S. NATIONAL SERIAL#

DATE UNDER 35 U.S.C.102(e)

DATE OF COMMENCEMENT OF
NATIONAL PROCESSING

All correspondence submitted after the date of commencement of U.S. National processing indicated above should refer to the U.S. National Serial Number and the appropriate U.S. National processing organization or Officer.

- B. ☐ As the above identified application has been accepted for U.S. National processing under the provisions of 35 U.S.C.371 (f) before expiration of the applicable time limit under ☐ PCT Article 22 ☐ PCT Article 39, applicant is reminded that
- ☐ Amendments under PCT Article 19 and/or
 - ☐ the International Preliminary Examination Report and its Annexes, if any, under PCT Article 36(3) (a), and (b)
- and any translation thereof, if applicable, must be submitted to the Patent and Trademark Office as soon as they are available.

COMBINED DECLARATION AND POWER OF ATTORNEY
IN ORIGINAL APPLICATION

ATTORNEY DOCKET NO.
9534

I declare: that my residence and citizenship are as stated below next to my name; that I believe I am the original, first and sole inventor (if only I am named below) or joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought in the specification ~~attached hereto~~ entitled

Sheet Feeding Apparatus, Application PCT/US97/05320, filed 01 April 1997

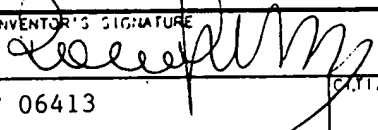

with the US Receiving Office ;

that I have reviewed and understand the contents of the above-identified specification, including the claims; that I acknowledge the duty to disclose information which is material to the examination of the application under 37 C.F.R. §1.56(a); that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

I appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Charles G. Nessler Reg. No. 27,825
P.O. Box H
Chester, CT 06412

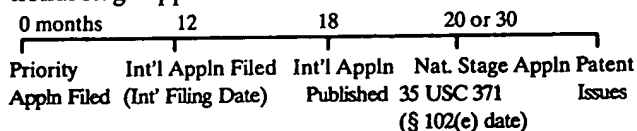
Send all correspondence to him

FULL NAME OF ROLE OR FIRST INVENTOR		INVENTOR'S SIGNATURE	DATE
Roman M. Golicz			06/23/97
RESIDENCE		CITIZENSHIP	
25 Indian Drive, Clinton, CT 06413		USA	
POST OFFICE ADDRESS same as above			
FULL NAME OF SECOND JOINT INVENTOR, IF ANY		INVENTOR'S SIGNATURE	DATE
Stefan G. Golicz			6/23/97
RESIDENCE		CITIZENSHIP	
26 Old Deep River Rd, Essex, CT 06426		USA	
POST OFFICE ADDRESS same as above			
FULL NAME OF THIRD JOINT INVENTOR, IF ANY		INVENTOR'S SIGNATURE	DATE
RESIDENCE		CITIZENSHIP	
POST OFFICE ADDRESS			

NATIONAL APPLICATIONS SUBMITTED UNDER 35 U.S.C. 371

These applications are the result of an international application filed under the PCT entering the national stage in the United States. They are called national stage applications. The national stage application papers are placed in a domestic application file wrapper and the phrase "FILED UNDER 35 U.S.C. 371" is stamped on the front of the file wrapper. In addition, a "Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) is placed in the file.

A typical time line involving an international and a national stage application is illustrated as follows:



Although the illustrated time line is typical, there is no requirement that there be a priority application, nor is there any requirement that the national stage application be submitted after the international application is published.

National stage applications submitted under 35 U.S.C. 371 are treated differently in certain respects than national applications filed under 35 U.S.C. 111(a). Treatment of 35 U.S.C. 371 applications differs from treatment of 35 U.S.C. 111(a) applications as follows:

A. FILING DATE AS APPLICANT'S DATE OF INVENTION

By virtue of 35 U.S.C. 363, the U.S. filing date of a national stage application is the international filing date (the filing date of the international application) for the purpose of determining whether information is prior art (i.e., has an effective date) relative to the invention claimed in the national stage application. The date which appears in the "filing date" box on the front of the file wrapper of a national stage application, however, is the date on which the requirements of 35 U.S.C. 371(c) were complied with, and typically is not the same as the international filing date of the application. The international filing date is the critical date for determining whether or not a particular reference is available as prior art against the application. The international filing date will appear next to the international application number in the CONTINUING DATA section on the file wrapper label

and in the "Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903).

B. 35 U.S.C. 119(a) PRIORITY IN NATIONAL STAGE APPLICATION

The filing date of a national stage application is the international filing date. Pursuant to 35 U.S.C. 365(b), a priority claim under 35 U.S.C. 119(a) is proper if (a) a claim for priority was made in the international application, and (b) the application was filed within 12 months prior to the international filing date. See MPEP § 1893.03(c). The examiner should acknowledge the priority claim and priority document in the next Office action and on the file wrapper as in any 35 U.S.C. 119(a)-(d) situation, if appropriate.

C. PRIORITY DOCUMENT

In national stage applications, a photocopy of the foreign priority document is received from the International Bureau and placed in the national stage application file. This copy of the foreign priority document is sufficient to establish that applicant has filed a certified copy of the priority document. The copy received from the International Bureau bears a "WIPO" stamp. If a copy of the foreign priority document is not in the national stage application file, the examiner should consult the Group's Special Program Examiner. A certified copy of a priority document filed as a U.S. provisional application under 35 U.S.C. 111(b) is not required under 35 U.S.C. 119(e).

D. UNITY OF INVENTION

Restriction practice in both international and national stage applications is determined under unity of invention principles as set forth in 37 CFR 1.475 and 1.499. Restriction practice under 35 U.S.C. 121, as it applies to national applications submitted under 35 U.S.C. 111(a), is not applicable to either international or national stage applications. However, a continuing application claiming benefit under 35 U.S.C. 365(c) to an international application or to a national stage application is not a national stage application and, therefore, the restriction practice under 35 U.S.C. 121 is applicable.

E. FILING DATE FOR PRIOR ART PURPOSES UNDER 35 U.S.C. 102(e)

Once a patent issues from a national stage application, the filing date for prior art purposes under